REMARKS

A. The Claims are Directed to Statutory Subject Matter Under 35 U.S.C. § 101

Claim 1 was rejected as non-statutory subject matter asserting that the claim fails to provide a physical transformation or be limited to a practical application. A useful, concrete, and tangible result must be either specifically recited in the claim "or flow inherently therefrom." See Overview of Interim Guidelines for Subject Matter Eligibility, Weinhardt at page 17.

Here, a useful, concrete, and tangible result flows expressly or inherently from claim 1. The result is that file data on a semiconductor memory can be located. Thus, semiconductor memories can be used to store compressed file data as actually recited in the claim and the compressed file data can be located, even though it is compressed, using information stored in that memory.

Thus, the useful result is at least inherently recited and, more pointedly, specifically recited within the claim. The suggestion that displaying a report is a more tangible result than locating data on the semiconductor memory, seems illusory and without basis. Similarly, the fact that the file data being outputted to the user is a more tangible result than locating the data itself seems equally illusory.

Therefore, reconsideration is requested.

Claim 40 calls for a system. It is necessarily statutory and the assertion to the contrary seems to be without any reasonable basis.

B. Claims 1-6, 9-15, and 19 are Patentable Under 35 U.S.C. § 102(b) Over Miller et al.

Miller et al. does not disclose locating file data on a semiconductor memory using information that is also stored in the semiconductor memory. In this regard, the portion of Miller et al. cited by the Final Office Action refers to addressing information that is maintained by an operating system, and that is recorded in operating system kernel data structures. *See* Miller et al. at col. 3, line 58 through col. 4, line 17. Nowhere does Miller et al. indicate that the data structures that contain the addressing information are stored in the semiconductor memory on which the file data is also stored. This conclusion results unavoidably from inspection of Figure 2 of Miller et al. That figure reveals that the compressed file data is stored in a memory 17. Conversely, the operating system kernel data structure resides in a different memory, i.e.

memory 11. In Miller et al., the information that is used to locate file data on a semiconductor memory is not stored in the semiconductor memory.

Furthermore, in an alternative embodiment, Miller et al. discloses an arrangement in which a memory controller maintains a table of information that indicates in which of a number of memory partitions a particular compressed page of data is stored. *See* Miller et al. at Col. 7, ll. 1-19. However, the information is not collocated with the data in the memory, as required by independent claims 1 and 10.

Consequently, because Miller et al. does not disclose the above-referenced limitation of claims 1 and 10, those claims are patentable under 35 U.S.C. § 102(b) over Miller et al.

In rejecting Claims 9 and 19, the Final Office Action asserts that "[i]t is inherent [in Miller et al.] that operating system [sic] is stored in semiconductor memory." Office Action at page 8, last paragraph. This assertion is not supported by the subject matter disclosed by Miller et al., or by prevailing law.

In order to validly maintain a rejection based on a purportedly inherent feature of a reference, that feature must necessarily exist in the reference, and its existence must be apparent to an ordinarily skilled artisan. *Glaxo Inc. v. Novopharm Ltd.,* 34 U.S.P.Q.2d 1565, 1566 (Fed. Cir. 1995), *cert. denied* 116 S. Ct. 516 (1995); *Continental Can Co. USA v. Monsanto Co.*, 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991). This prerequisite has not been satisfied by Miller et al., and has been ignored in the Office Action. It is noteworthy that in rejecting claims 9 and 19, the Office Action includes no reference to any portion of Miller et al. that might be relied on as constituting an explicit or inherent disclosure of an operating system that is stored in semiconductor memory. The absence of any citation to Miller et al. results directly from the fact that Miller et al. fails to provide any suggestion, inherent or otherwise, of an operating system that is stored in semiconductor memory. Consequently, the Office Action fails to formulate a *prima facie* case for the anticipation of claims 9 and 19 based on Miller et al.

For the reasons articulated above, reconsideration of the rejection of claims 9 and 19 is respectfully requested.

C. Claims 7, 8, and 16-18 are Patentable Under 35 U.S.C. § 103(a) Over Miller et al. In View of Garner et al.

Claims 7 and 16 are directed to a file system image to which there is affixed a header that provides information regarding how to locate blocks of data in file system image. The Office

Action first asserts that Garner et al. does teach a file system image having such a header and further asserts that "it would have been obvious...to include a header with a pointer and file size in the method of Miller et al." Office Action at page 11. According to the Office Action, the combination of Miller et al. and Garner et al. is justified "because it allows condition [sic] of the sectors to be transferred thus aiding in determining error in data transfer." *Id.*

The Office Action fails to identify a legally tenable motivation or suggestion to combine Miller et al. and Garner et al. In the absence of the requisite motivation or suggestion to combine the cited references, the Office Action has failed to establish a *prima facie* case of obviousness with respect to claims 7, 8 and 16-18.

In order to establish obviousness based on a combination of elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination in a manner that results in the claimed subject matter. *See In re Dance,* 48 U.S.P.Q.2d 1635, 1637 (Fed. Cir. 1998); *In re Gordon*, 221 U.S.P.Q. 1125. 1127 (Fed. Cir. 1984). The motivation, suggestion or teaching to combine references may come explicitly form the statements in the prior art, the knowledge of one with ordinary skill in the art, or, in some cases, the nature of the problem to be solved. *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Whether the Office Action relies on an express or implicit showing of a motivation or suggestion to combine Miller et al. with Garner et al., it must provide particular findings related thereto. *In re Dembiczak*, 50 U.S.P.Q.2d at 1617 (Fed. Cir. 1999). Broad conclusory statements standing alone are not "evidence." *Id.*

That is to say, with respect to the subject patent application, the Office Action must include particular factual findings that support an assertion that a skilled artisan would have combined the express disclosures of Miller et al. and Garner et al. to develop the subject matter recited in claims 7, 8, and 16-18. *See In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317. The specific subject matter set forth in Claims 7, 8, and 16-18 includes, in pertinent part, locating a compressed file data on a semiconductor memory using information provided by a header that is affixed to the file system.

The Office Action is devoid of an evidentiary basis that might substantiate a motivation to combine Miller et al. and Garner et al. in a manner that would result in these features. The Office Action concedes, as it must, that Miller et al. does not teach the use of a header to locate compressed data in a file system. However, the Office Action asserts that Garner et al. may be

combined with Miller et al. in a manner that renders the claims unpatentable. The proffered justification for the requisite combination is untenable under prevailing patent law.

Specifically, the Office Action asserts that a skilled artisan would be motivated to add the header disclosed in Garner et al. to the semiconductor RAM of Miller et al. because the header of Garner et al. "allows condition [sic] of the sectors to be transferred thus aiding in determining error in data transfer." Office Action at page 11.

Furthermore, Miller et al. requires no embellishment of the kind that the Office Action suggests. That is, Miller et al. has no need for the header disclosed by Garner et al. Miller et al. adequately effects error correction through the use of an ECC circuit that is situated between a data compression mechanism 16 and semiconductor memory 17. *See* FIG. 1 of Miller et al. Therefore, Miller et al. *teaches away* from the use of an error-detecting header that is affixed to data files. That is there is no motivation to be found in Miller et al. for the inclusion of a header as asserted in the Office Action.

In addition, the proposition that a skilled practitioner would be motivated to look to Garner et al. for techniques that might be availing to Miller et al. is dubious. The paramount concern addressed in Miller et al. is a virtual memory system that allows high-speed page swapping between main memory and virtual memory. Miller et al. indicates that the prior art, i.e. hard disks, was undesirably slow in this respect and, as a solution, offers a technique that enables semiconductor RAM to be substituted. *See* Miller et al. at col. 1, line 19 through col. 2, line 42. Given the stated objectives of Miller et al., there is no likelihood that the flash memory disclosed in Garner et al. would be attractive for any purpose addressed by Miller et al. Flash memories are known to have a number of attributes that render that particular memory technology entirely inapposite in the application of Miller et al. For example, flash memory is relatively slow and must be erased in blocks. A disadvantage of the block-oriented nature of flash is that it cannot be practicably used as, or as an adjunct to, main memory. *See Microsoft Computer Dictionary (Fifth Edition)*, page 216.

Accordingly, the Office action fails to make a *prima facie* of obviousness of claims 7, 8, and 16-18 based on Miller et al. and Garner et al.

The Office Action irrefutably engages in the hindsight-based obviousness analysis that has been widely and soundly disfavored by the Federal Circuit. In order to prevent a hindsight-based obviousness analysis, the Federal Circuit has established that the relevant inquiry for determining the scope and content of the prior art is whether there is a reason, suggestion, or

motivation in the prior art or elsewhere that would have led one of ordinary skill in the art to combine or modify references. *See Ruiz v. A.B. Chance Co.,* 57 U.S.P.Q.2d 1161, 1167 (Fed. Cir. 2000).

With respect to the subject patent application, the Office Action contains no factual support for the manner in which a skilled practitioner would be motivated to combine Miller et al. and Garner et al. to render unpatentable claims 7, 8, and 16-18. *See In re Lee*, 61 U.S.P.Q.2d 1430, 1435 (Fed. Cir. 2001). The factual question of motivation to combine is material to patentability, and cannot be resolved on subjective belief and unknown authority. *Id.* (citing *W.L. Gore v. Garlock, Inc.,* U.S.P.Q. 303, 312, 313 (Fed. Cir. 1983)). The Office Action must not only assure that requisite findings are made based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the rejection.

Because the Office Action fails to adduce any legally probative factual findings that would support, even inferentially, a motivation for, or suggestion of, the way by which Miller et al. and Garner et al. might be combined to yield the subject matter in claims 7, 8, and 16-18, a *prima facie* case of obviousness has not been made. Accordingly, claims 7, 8, and 16-18 are patentable over the cited art.

Respectfully submitted,

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Timothy N. Trop, Reg. No. 28,994
TROP, PRUNER & HU, P.C.
1616 South Voss Road, Suite 750
Houston, TX 77057-2631
713/468-8880 [Phone]
713/468-8883 [Fax]

Attorneys for Intel Corporation